

REMARKS

Claims 46-48 and 50-56 are currently pending in this application. In light of the comments presented below, reconsideration and allowance of the claims of this application are respectfully requested.

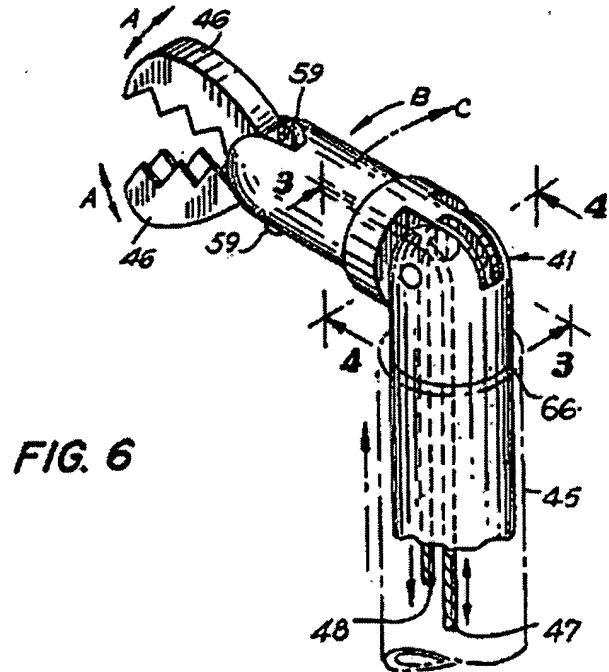
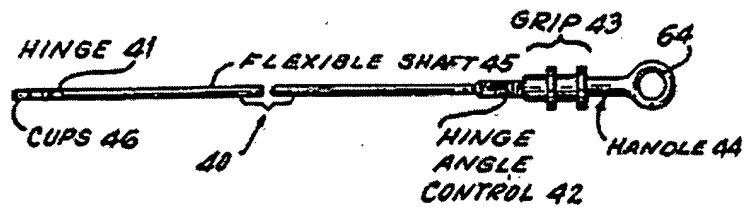
Applicants would like to thank Examiner Webb for her time and consideration extended to Applicant's representative, Christopher Trainor, Esq., during the telephone interviews conducted on May 5, 2005 and June 8, 2005. During the interviews, the issue of whether the Office Action was properly made final was discussed. Mr. Trainor pointed out to Examiner Webb that the only amendment to the claims in the Amendment filed March 4, 2005 was to correct a typographical error in Claim 46. Since the amendment did not necessitate the new grounds of rejection in the Office Action mailed April 5, 2005, Mr. Trainor argued that the finality of the Office Action was improper. Examiner Webb agreed that the finality of the rejection was improper and agreed to withdraw the finality upon filing of these Remarks.

In the Office Action, Claims 46-48, 50-53, 55 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,880,015 ("Nierman") in view of U.S. Patent No. 5,235,966 ("Jamner"). Nierman discloses biopsy forceps 40 shown in FIGS. 5 and 6, reproduced below, for use through a flexible fiberoptic bronchoscope. Forceps 40 includes a handle 44 having an angle control 42, a flexible metal shaft 45, forceps cups 46, and wires 47 and 48. Wire 47 is connected at one end to biopsy cups 46. The other end of wire 47 is connected to a sliding outer plastic grip 43 of handle 44 to control opening and closing of cups 46. Wire 48 is

Appl. No. 10/037,977
Amdt. Dated June 27, 2005
Reply to Office Action of April 5, 2005

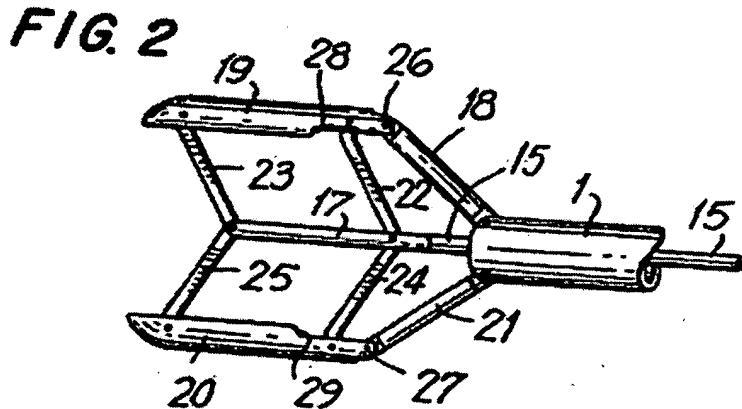
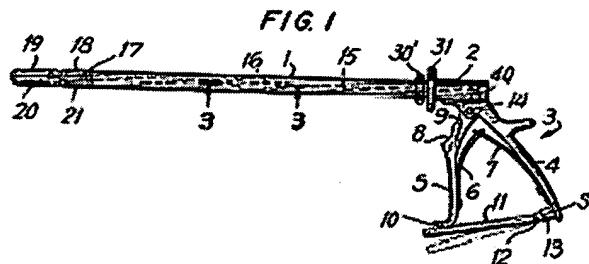
connected at one end to hinge control 42 and at a second end to elements 54 and 55 such that hinge control 42 can be actuated to control the angle of the distal end of the forceps.

FIG. 5



Jammer discloses an endoscopic retractor shown in FIGS. 1 and 2 reproduced below including a handle grip 3, a hollow tubular shaft 1, a pivot support means 17 and retractor blades 19 and 20. The handle grip 5 has a movable trigger 5 having a lug 40 positioned to engage a

proximal end of an actuating rod 15. Actuating rod 15 extends through hollow shaft 1 and is affixed to pivot support means 17. Coupler links 22-25 pivotally connect support means 17 to retractor blades 19 and 20 such that movement of trigger 5 effects movement of retractor blades 19 and 20 between open and closed positions.



Jammer also discloses a finger nut 30' which is secured to tubular shaft 1. Finger nut 30' can be rotated to rotate the entire tubular shaft 1 with retractor blades 19 and 20 "to provide optimum positioning with minimum instrument movement."

Claim 46 recites an endoscopic surgical apparatus including, inter alia, a handle portion,

Appl. No. 10/037,977
Amtd. Dated June 27, 2005
Reply to Office Action of April 5, 2005

an endoscopic portion rotatable in relation to the endoscopic portion, an articulating portion pivotally supported on a distal end of the endoscopic portion and a tool head supported by the articulating portion.

In the Office Action, the Examiner states the following:

“Nierman fails to form the tubular endoscopic portion (45) so that it rotates with respect to the handle portion. Jamner discloses a similar endoscopic device with a handle portion (3), movable jaws (19, 20), and an elongate tube (1). Jamner teaches that a mechanism for rotating the elongate tubular portion (1) relative to the handle (3) should be included to provide optimum positioning with minimum instrument movement (column 3, lines 59-66). The mechanism is in the form of a rotating collar (31) secured to the proximal end of the shaft (1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the tubular endoscopic portion of Nierman so that it rotates relative to the handle, as Jamner teaches that this allows the user to rotate the shaft and jaws without rotating the entire instrument.”

Applicants respectfully disagree with the Examiner’s contention that it would have been obvious to modify Nierman’s endoscopic portion in view of Jamner’s disclosure so that it rotates relative to the handle. As discussed above, Nierman’s biopsy forcep cups 46 are driven between open and closed positions by a wire 47 and the distal end of Nierman’s forceps are driven in articulation by a wire 48. Wires 47 and 48 are fixedly connected to sliding plastic outer grip 43 and hinge control 42, respectively. Nierman’s biopsy forceps could not be modified in the manner suggested by the Examiner without substantially modifying the handle structure of Nierman’s device. More specifically, if Nierman’s device were modified in the manner suggested by the Examiner and purportedly suggested by Jamner, upon rotation of shaft 45, cables 47 and 48 would be wrapped about each other. There is no suggestion or teaching in

Appl. No. 10/037,977
Amdt. Dated June 27, 2005
Reply to Office Action of April 5, 2005

either Nierman or Jamner which would direct one of ordinary skill in the art how to overcome such a problem. It is noted that Jamner is only able to rotate his shaft 1 because lug 40 of trigger 5 merely abuts the proximal end of actuating rod 15. Such is not possible in a wire driven device such as Nierman's forceps.

It is noted that in the background of Nierman, Nierman discusses prior art devices which require rotation of the entire instrument to provide access to tissue during a variety of surgical procedures (Column 2, lines 36-42). Although Nierman is aware of the benefits of providing a rotatable endoscopic shaft, Nierman fails to disclose such a feature in his biopsy forceps despite the existence of Jamner's retractor. This would seem to indicate that the modification of Nierman's device in view of Jamner's disclosure involved something substantially more complex than obvious design changes.

For the reasons discussed above, Claim 46 patentably distinguishes over Nierman and Jamner, taken alone or in combination. For at least these same reasons, *inter alia*, Claims 47, 48, 50-53, 55 and 56, which depend either directly or indirectly from Claim 46, also patentably distinguish over Nierman and Jamner.

In the Office Action, Claim 54 was rejected under 35 U.S.C. § 103(a) over Nierman in view of Jamner and further in view of U.S. Patent No. 5,350,391 ("Iacovelli"). Claim 54 depends from Claim 46. Iacovelli fails to cure the deficiencies of Nierman and Jamner as discussed above. For at least the reasons discussed above with respect to Claim 46, Claim 54 patentably distinguishes over Nierman, Jamner and Iacovelli taken alone or in combination.

In view of the foregoing remarks, it is respectfully submitted that all claims pending in the application, namely claims 46-48 and 50-56, are in condition for allowance. Should the

Appl. No. 10/037,977
Amtd. Dated June 27, 2005
Reply to Office Action of April 5, 2005

Examiner feel that a telephone or personal interview may facilitate resolution of any remaining matters, she is respectfully requested to contact Applicant's attorney at the number indicated below.

Respectfully submitted,

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